

REMARKS

Independent claims 1 and 13 have been amended for clarity, and dependent claim 5 has been amended for better correspondence between the thread form profiles recited in both claims. Now both claims 1 and 13 state that the thread or thread form profiles in the respective legs are offset from each other by half the pitch of the threads of the rod.

The indication of allowable subject matter in claims 9-12 and 21-24 is noted with appreciation.

In a new rejection even more perplexing, the Examiner has now rejected claims 1, 5-8, 13 and 17-20 as unpatentable over the plastic outlet box of Lass in view of Havener. The newly cited Lass patent does not disclose a threaded rod hanger or any semblance of such hanger, and what the Examiner proposes to do to Lass or Havener in view of the other would make both inoperative for their intended purposes.

The plastic outlet box of Lass has an open top and four sides with a closed bottom as seen in Figure 1 and is secured to a wall by fasteners which extend through the holes 22 (see bottom of Col. 2).

In order to hold the switch or socket, for example, in the box the latter is provided with a strap shown only at 80 in Figure 5, and the strap is secured to the box by screws S pushed through holes 64 at each end of the rectangular box. The screws fit through the mickey-mouse shaped holes 40 in the legs 36 of plastic clips 32, which legs extend through slots 66 in the end wall of the box. There are two clips, one for each end wall. When fully inserted as seen in Figure 5 the holes in the clips line up with the holes 64 in the box.

As seen more clearly in Figures 2 and 4 the holes each include projections between the mickey-mouse shaped ears, which terminate in edges 44 at the bottom of inclined ramps 48.

The projecting edges and ramps act like ratchet teeth cooperating with the threads of the screw S.

“...so that normal thumb pressure will cause the threads to slide along the inclined surfaces or ramps 48.

This thumb pressure is sufficient to allow the threaded fastener to be inserted axially into passage 60 until the screw head bottoms out on the upper surfaces of the strap 80 (Fig. 6) forming part of a component received into space 16.” (Col. 4, lines 9-16).

Any structural threaded rod hanger where the rod could be moved down by finger pressure would be inoperative or a failure. Thus Lass would make Havener inoperative.

The authorities on the subject of whether it would be obvious to destroy or render inoperative a prior device are pretty straightforward.

In *In re Schulpen*, the CCPA indicated:

Rather than being made obvious by the reference, such modification would run counter to its teaching by rendering the apparatus inoperative to produce the disclosed tire patches. *In re Schulpen* 157 USPQ 52, 55, (CCPA 1968).

In *Ex Parte Hartmann*, 186 USPQ 366 at 367, (1974) the PTOBA held that references cannot properly be combined if the effect would destroy the invention on which one of the reference patents is based. These decisions by the CCPA and Board of Appeals were precursors of the well known decision by the Federal Circuit found in *In re Gordon* 221 USPQ 1125, 1127 (Fed. Cir. 1984), involving the inoperative up-side-down oil filter.

This Federal Circuit decision is perhaps best summarized in footnote 12 found in the subsequent recent case of *In re Fritch* 23 USPQ 2d 1780, at 1783 (Fed. Cir. 1992). Such footnote states:

¹²This court has previously found a proposed modification inappropriate for an obviousness inquiry when the modification rendered the prior art reference inoperable for its intended purpose. *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

In addition to *In re Fritch*, *Gordon* has been followed in *In re Kramer* 18 USPQ 2d 1415, 1416 (Fed. Cir. 1991 unpub.), *In re Chu* 36 USPQ 2d 1089, 1094 (Fed. Cir. 1995), and in *Bausch & Lomb Inc. v. Barnes-Hind/Hydrocurve Inc.* 10 USPQ 2d 1929, 1934 (N.D. Calif. 1989).

The primary reference is not a structural threaded rod hanger and to modify it to be one would make it inoperative, since a screw taking a hanging load can't function as such if movable by finger pressure. Moreover to put large notches or gaps in the side walls of the plastic switch box of Lass to clamp it on a beam flange with a non-existent clamp screw, which would have to go through the switch or socket, would make Lass inoperative for its purpose, not to mention

making it non-code compliant. One can't safely enclose an electrical switch and still provide openings or notches to receive a beam flange for example.

The authorities above may be reviewed again.

Moreover, the plastic switch or outlet box with the finger push screws to secure the switch or outlet to the box is not analogous to a threaded rod hanger for supporting a load from a structure. The two-way inoperativeness of the combination proposed by the Examiner is ample proof of the lack of an analogous relationship between the two references.

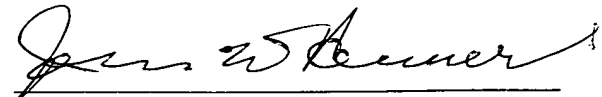
Finally it is apparent from but a cursory review of the rejected claims that neither reference comes close to showing, teaching or suggesting all of the limitations of the claims rejected. One need look no farther than the two independent claims, although the dependent claims rejected include even more non-disclosed, non-suggested and not even mentioned limitations.

For example, Lass doesn't have parallel slots in opposite side walls, with a single clip spanning the walls. Lass has two clips, one for each end wall. Nor is Lass' ratchet tab even remotely similar to applicants' claimed offset thread forms. Nor are there any angled projections to guide the tips of the clip.

In view of the foregoing, and in the absence of any further prior art, this application is submitted as in condition for final allowance. Early action to that effect being respectfully submitted.

Should any deficiencies or overpayments occur in the filing fees of the subject amendment, authorization is hereby given to charge Deposit Account Number 18-0988.

Respectfully submitted,



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